

CIP 2166



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 Fax Number: (703) 746-4000 Telephone No.:  
 From: André L. Marais Reg. No. 48,095  
 Date: March 21, 2002 Time: 3:40 p.m.  
 Operator: Sarah M. Montgomery Matter: 5214P001RD3  
 Number of pages including cover sheet: 8  
 In Re Patent Application of: Kuriacose Joseph, et al.  
 Application No.: 09/903,457  
 Filed: July 10, 2001  
 For: APPARATUS FOR TRANSMITTING AND RECEIVING EXECUTABLE APPLICATIONS  
AS FOR A MULTIMEDIA SYSTEM, AND SYSTEM TO ORDER AN ITEM USING A  
DISTRIBUTED COMPUTING SYSTEM  
 Enclosed are the following documents: Notice of Litigation Under 37 C.F.R.  
1.178 (2 pgs.) and Exhibit A (Complaint for Patent Infringement) (5pgs.)

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(Rev. 11/23/97)



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Attorney's Docket No.: 5214P001RD3

Patent

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kuriacose Joseph, et al.

Examiner: Kalinowski, A.

Application No.: 09/903,457

Art Group: 2166

Filing Date: July 10, 2001

For: APPARATUS FOR TRANSMITTING  
AND RECEIVING EXECUTABLE  
APPLICATIONS AS FOR A  
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Assistant Commissioner for Patents  
Washington, D.C. 20231

NOTICE OF LITIGATION UNDER 37 C.F.R. 1.178

Sir:

Notice is hereby provided that U.S. Patent No. 5,819,034, on which the above Reissue Patent Application is based, is involved in litigation. Specifically, the Assignee OpenTV, Inc. on February 7, 2002, filed a complaint in the U.S. District Court of Northern California alleging infringement by Liberate Technologies of U.S. Patents Nos. 5,819,034 and 5,563,648. A copy of the complaint is attached.

Regarding the status of this litigation, only the above noted complaint has been filed to date. The Examiner is invited to contact the undersigned attorney with any questions relating to the current status of the litigation.

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Sarah M. Montgomery

(Signature of person transmitting paper)



If there are any fees in connection with this Notice, please charge Deposit Account No. 02-2666.

A duplicate of this Notice is enclosed for deposit account charging purposes.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 03/21/ 2002

  
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## EXHIBIT A

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**COPY**

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6 Attorneys for Plaintiff  
 7 OPENTV, INC.

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RICHARD W. WIEKING  
 CLERK, U.S. DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 OAKLAND

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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

**ADR**

11 OPENTV, INC., a Delaware corporation,

12 Plaintiff,

13 v.

14 LIBERATE TECHNOLOGIES, a Delaware  
 15 corporation,

16 Defendant.

No.

**C 02 0655 JL**

COMPLAINT FOR PATENT  
 INFRINGEMENT

DEMAND FOR JURY TRIAL

17 Plaintiff OpenTV, Inc. ("OpenTV"), as its Complaint against Defendant Liberate

18 Technologies ("Liberate"), alleges as follows:

19 **PARTIES**

20 1. OpenTV is a corporation incorporated under the laws of Delaware, with its principal  
 21 place of business at 401 East Middlefield Road, Mountain View, California 94043.

22 2. Liberate is a corporation incorporated under the laws of Delaware, with its principal  
 23 place of business at 2 Circle Star Center, San Carlos, California 94070.

24 **JURISDICTION AND VENUE**

25 3. This action arises under the patent laws of the United States, Title 35 of the United States  
 26 Code. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C.  
 27 §§ 1338(a) (action arising under an Act of Congress relating to patents) and 1331 (federal question)  
 28 and 35 U.S.C. § 281.

COMPLAINT FOR PATENT INFRINGEMENT  
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4. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1331, 1333 and  
1400(b), in that Liberate resides in this district, is subject to personal jurisdiction in this district and  
3 has committed acts of infringement in this district.

**4 PRELIMINARY STATEMENT**

5. OpenTV is one of the world's leading interactive television technology companies.

6. OpenTV builds a complete "middleware" platform that enables digital interactive television.

7. OpenTV is the sole owner of numerous United States Patents in the field of digital  
8 interactive television, including: United States Patent No. 5,563,648, issued on October 8, 1996 (the  
9 "648 patent"), which is attached hereto as Exhibit A; and United States Patent No. 5,819,034, issued  
10 on October 6, 1998 (the "034 patent"), which is attached hereto as Exhibit B. The '648 patent and  
11 the '034 patent are referred to collectively herein as "the OpenTV patents."

12. Liberate competes against OpenTV in the interactive television market, developing and  
13 marketing interactive television middleware platforms under the Liberate name. OpenTV has not  
14 licensed Liberate under the OpenTV patents.

**15 PATENT INFRINGEMENT BY LIBERATE**

16. OpenTV is informed and believes, and on that basis alleges, that Liberate has infringed  
17 and continues to infringe, directly or indirectly, the OpenTV patents by its unlicensed use, promotion,  
18 manufacture, and offering for sale, in this judicial district and elsewhere in the United States, of  
19 interactive television middleware.

20. OpenTV is informed and believes, and on that basis alleges, that Liberate's infringement  
21 of the OpenTV patents has been and will continue to be willful.

22. OpenTV is damaged and irreparably injured by Liberate's infringing activities and will  
23 continue to be so damaged and irreparably injured unless Liberate's infringing activities are enjoined  
24 by this Court.

**25 PRAYER FOR RELIEF**

26. WHEREFORE, OpenTV requests that the Court:

27. A. Enter judgment that OpenTV is the owner of the OpenTV patents and all rights of  
28 recovery under each of them, and that each of those patents was duly issued and is valid;

- 1        B.     Enter judgment that Liberate has infringed the OpenTV patents, directly or indirectly;
- 2        C.     Preliminarily and permanently enjoin Liberate, its officers, agents, servants,
- 3     employees and those in concert or participation with them, from any unlicensed use of the inventions
- 4     claimed in the OpenTV patents;
- 5        D.     Award OpenTV damages as compensation for Liberate's infringement of the OpenTV
- 6     patents, such award to include prejudgment interest;
- 7        E.     Treble such award of damages due to the willful nature of Liberate's infringement of
- 8     the OpenTV patents;
- 9        F.     Declare that this is an exceptional case under 35 U.S.C. § 285 and award OpenTV its
- 10    attorneys' fees and expenses in this action;
- 11    G.     Award OpenTV its costs in this action; and
- 12    H.     Enter such other and further relief to which OpenTV may be entitled as a matter of
- 13    law, or which may otherwise be just and proper.

14 Dated: February 7, 2002

HAROLD McELHINNY  
MICHAEL A. JACOBS  
GEORGE C. HARRIS  
MORRISON & FOERSTER LLP

By: Michael A. Jacobs

Attorneys for Plaintiff  
**OPENTV, INC.**

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### DEMAND FOR JURY TRIAL

2 Plaintiff OpenTV hereby demands trial by jury of all claims and counterclaims in this action  
3 for which there is a right to trial by jury.

4 Dated: February 7, 2002

5 HAROLD McELHINNY  
6 MICHAEL A. JACOBS  
7 GEORGE C. HARRIS  
8 MORRISON & FOERSTER LLP  
9

10 By:   
11 Michael A. Jacobs

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10 Attorneys for Plaintiff  
11 OPENTV, INC.